

REMARKS

Rejection under 35 USC § 103(a)

It is basic patent law that the rejection of the present invention under 35 U.S.C. § 103 must comport with the classic standard set forth in *Graham v. John Deere Company* 383 US 1, 148 USPQ 459 (1966), codified in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must:

- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (3) Explain why the proposed modification would be obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch*, 972 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

The Examiner has rejected Claims 1 and 4-11 under 35 USC § 103(a) as allegedly obvious over Kaiserman (hereinafter "Kaiserman") U.S. Patent No. 5,338,474 as applied to the present claims alone, in addition to or in combination with Ofosu-Asante et al. (hereinafter "Ofosu") WO Patent No. 98/03621. The Examiner asserts that it would have been obvious to formulate a bleaching composition containing a specific diacyl peroxide which provides stain removal and improved fabric color safety as recited by the instant claims, with a reasonable expectation of success because of the broad teachings of Kaiserman and Ofosu.

First, the Kaiserman disclosure is limited to a composition and does not teach a method of removing stains from fabric and improving fabric color safety. In order for a reference to be anticipatory upon a theory of inherency under an obviousness rejection, the limitation must necessarily flow from the teachings of a single reference. See, e.g., *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) ("If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' ... 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f 1990) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.") (emphasis added).

Since the Examiner admits that Kaiserman does not teach a method of removing stains from fabric and improving fabric color safety (see Office Action, Paper 4, page 6, 1st paragraph), there is no extrinsic evidence that necessarily flows from Kaiserman to believe that a reasonable expectation of success and similar results could be achieved. Thus, an obviousness rejection based on inherency cannot be established.

Second, though Kaiserman teaches that the composition is useful in normal basic aqueous solutions, neutral solutions and "even in acidic solutions" (see Kaiserman, col. 3, lines 49-53), the Examiner's attention is drawn to the fact that Kaiserman cites only examples of compositions having a neutral or alkaline pH level ranging from 7-10 (see Kaiserman, col. 7, lines 42-49). It is settled law that broad-scale disclosures in the art are not dispositive of the issue of patentability under 35 U.S.C. 103. *Ex parte Hyamizu*, 10 U.S.P.Q. 1393, 1394 (BPAI 1988). The Applicants submit that at the time of the invention, Kaiserman did not contemplate using a pH level of between about 2 and about 5 as in the present invention with an expectation of success required by case law cited above and in the previous amendment(s). Had Kaiserman contemplated an acidic composition, Kaiserman would have included at least one example in the acidic range. Thus, the obviousness rejection also fails.

Though Ofosu teaches a method of treating fabric comprising a bleaching agent which may be diacyl peroxide at a pH level of from about 3 to about 10 (see Ofosu, page 4, 2nd paragraph), Ofosu requires the use of a microwave (see Abstract and Claim 1) to remove stains from fabrics. The Applicants, on the other hand, do not require microwave energy to remove stains. Thus, there is no motivation or expectation of success in Ofosu to use a bleaching agent such as diacyl peroxide to clean stains without using a microwave to arrive at the Applicants' invention.

Furthermore, the Examiner's attention is drawn to the fact the Applicants' invention discloses a method of using an aliphatic-aromatic diacyl peroxide to deliver improved fabric color safety. Ofosu is silent on a method providing the benefit of fabric color safety.

In short, it is submitted that the Examiner's conclusion that it would be obvious to expect success and similar results without the use of a microwave to arrive at the Applicants' method comprising a bleaching composition containing a specific diacyl peroxide composition having a pH of between about 2 to about 5 to provide stain removal and improved fabric color safety with respect to the broad disclosure of the referenced art to arrive at Applicant's invention flies in the face of reason.

In summary, it is submitted that either Kaiserman or Ofosu, alone or in combination are inappropriate in the present circumstances in view of the case law cited hereinabove. Accordingly, reconsideration and withdrawal of the rejection of Claims 1 and 4-11, as amended, are respectfully requested.

CONCLUSION

Applicant has made an earnest effort to place the present claims in condition for allowance. WHEREFORE, entry of the amendment provided herewith, reconsideration of the claims as amended in light of the remarks provided, withdrawal of the claims rejection, and allowance of Claim 1, as amended, and Claims 4-11 are respectfully requested. In the event that issues remain prior to allowance of the noted claims, the Examiner is invited to call Applicant's undersigned Attorney to discuss any remaining issues. He can be reached at the Procter & Gamble Company at (513) 627-7386.

Respectfully submitted,

By 

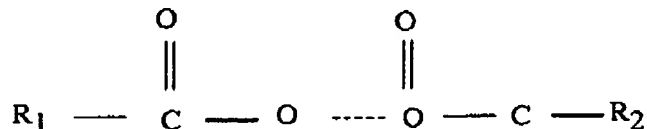
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CM 1903 After-Final Amendment

VERSION WITH MARKED UP CHANGES**IN THE CLAIMS**

Claim 1 has been amended.

1. (Amended) A method for removing stains from fabrics and improving fabric color safety, said method comprising the step of contacting a soiled fabric with a bleaching composition comprising a diacyl peroxide of general formula:



wherein R_1 is an aliphatic group having from 1 to 30 carbon atoms and is selected from either linear, branched, cyclic, saturated, unsaturated, substituted, unsubstituted or mixtures thereof and R_2 is an aromatic group selected from mono or polycyclic ring, homo or heteroatomic, substituted or unsubstituted or mixtures thereof; and wherein said composition having a pH of between about 2 to about 5.